

REMARKS

Claims 1-4 and 7 have been examined and have been rejected under 35 U.S.C. § 102(b).

I. Rejection under 35 U.S.C. § 102(b)

Claims 1-4 and 7 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Koike (US 2002/0189970). Applicant traverses this rejection.

A. Claim 1

Claim 1 recites a shock absorbing material having “a hole for deaeration which is formed so as to penetrate between a first surface thereof which is brought into contact with an inner surface of a packaging carton when said shock absorbing material is placed in said packaging carton, and a second surface thereof on which a product to be packed is placed via a thin film member”, which the Examiner asserts is disclosed by Koike. In particular, the Examiner maintains that, “holes are formed on all sides of the shock absorbing material”. For example, the Examiner asserts that figure 1 of Koike shows opening spaces between hollow projections (15, 25 and 35), on all sides, of each of shock absorbing materials (10, 20 and 30), and that figures 2A and 2B show the hollowed places (i.e., the opening spaces) between projections (25 and 35) on all sides of each of shock absorbing materials (20 and 30). Moreover, the Examiner asserts that figures 4, 6 and 8 of Koike show that when the shock absorbing materials (10, 20 and 30) are stacked with the article (50) in between them, holes are formed between the article being packed and the shock absorbing materials. Applicant traverses these assertions.

Koike discloses a lower pad 20, for example, having a plurality of hollow projections 25 protruding therefrom so as to surround a storage space 21 for a projector 50 (paragraph 40).

Koike also discloses that a connector 26, which does not protrude from the base as far as the hollow projections 25, connects adjoining hollow projections 25 (paragraph 55). It appears that the Examiner contends that the space above the connectors 26 in figures 1, 2A and 2B form a "hole" which discloses the hole feature of the claimed invention. However, the space asserted by the Examiner is merely a gap between projections and does not *penetrate* between a first surface (e.g., outer surface) and a second surface (e.g., inner surface) of the shock absorbing material, as required by claim 1. That is, the spaces of Koike are merely a result of adjacent hollow projections 25 and do not themselves actually penetrate the hollow projections 25 (i.e., the surfaces thereof). Therefore, the space of Koike is not a hole which is enclosed by the shock absorbing material, and thus not a hole, as required by claim 1.

On page 4 of the Office Action, the Examiner cites five definitions for "hole". Applicant notes that MPEP § 2173.01 states that a fundamental principle contained in 35 U.S.C. § 112, second paragraph, is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. In the present case, the specification makes clear in figures 4 and 5 that the hole penetrates the first and second surfaces through the shock absorbing material, as well as being fully enclosed by the structure of the shock absorbing material. The Applicant is entitled to claim their invention using terms consistent with the usage in the specification. Therefore, Koike does not disclose a hole for deaeration which is formed so as to penetrate between a first surface thereof which is brought into contact with an inner surface of a packaging carton when said shock absorbing material is

placed in said packaging carton, and a second surface thereof on which a product to be packed is placed via a thin film member, as required by claim 1.

In addition, it appears that the Examiner contends that the space above arrow 10 in figure 4 of Koike forms a "hole" which discloses the hole feature of the claimed invention. However, this space is merely formed by a *recess* in the upper pad 10, and does not *penetrate* a surface of the upper pad 10. In particular, the space does not penetrate between the first surface of the shock absorbing material, which is brought into contact with an inner surface of a packaging carton, as required by claim 1. In addition, since the space does not form a connection to a first surface, the space could not function for deaeration.

Accordingly, Koike fails to anticipate under 35 U.S.C. § 102 because it does not disclose each and every element of claim 1. Applicant submits that claim 1 is patentable for at least this reason.

B. Claims 2-4 and 7

Since claims 2-4 and 7 are dependent upon claim 1, Applicant submits that such claims are patentable at least by virtue of their dependency.

II. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No.: 10/542,374

Attorney Docket No.: Q87773

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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Date: July 26, 2007